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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,993	07/13/2001	Patricia Prekschat	31716US1	3817

116 7590 04/24/2002

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EXAMINER

KOEHLER, ROBERT R

ART UNIT

PAPER NUMBER

1775

7

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>
	09/904,993	PREIKSCHAT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Robert R. Koehler	1775

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 13 July 2001. (Prel. Ammt.)  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-36 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-36 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/171,558.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s) *ROK*.

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1,5,6</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Specification***

1. The abstract of the disclosure is objected to because it refers to "(Fig. 2)" in line 19.

The wording "(Fig. 2)" should be deleted. Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities: The specification refers to the claim numbers at lines 6 to 11 on page 1, lines 5 to 8 on page 6, line 31 on page 6, and lines 6 to 7 on page 16. All references in the specification to the claim numbers must be removed.

Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: A brief description of Figure 38 has not been presented on page 7. Only Figures 1 to 37 have been described.

Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: In line 17 on page 10, Figure 1 is incorrectly identified as containing various values of the rate constant " $k_j$ ." Figure 1 only refers to a color comparison of various passivated metal specimens. The Examiner believes that " $k_j$ " constants are presented in Figure 38. Also, note that in line 1 on page 11, the wording "(originally Illustration 1)" should be deleted.

Appropriate correction is required.

5. The disclosure is objected to because of the following informalities: Lines 13 to 15 and 17 to 19 on page 17 should not rely on the page number of the specification. It should be

sufficient to identify the conventional chromations by referring to the specific method groups presented in DIN 50960 (i.e., see lines 12 and 30 on page 2).

Appropriate correction is required.

6. The disclosure is objected to because of the following informalities: The kinetics term in line 4 on page 10 is not written clearly. The left parenthesis overlaps the letter "h" of "tanh," and the right parenthesis is missing.

Appropriate correction is required.

7. The disclosure is objected to because of the following informalities: The Examiner respectfully suggests that the specification includes appropriate section headings in order to subdivide the text into specific portions having recognizable subject matter.

Appropriate correction is required.

### ***Drawings***

1. Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the U.S. Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

The Examiner notes that Figures 1, 3, and 4 utilize color photographs for the purpose of describing conventional "chromation" and the applicants' invention.

2. The drawings are objected to because the depth profile analyses in Figures 5 to 35 are not clearly labeled for each reported element. For example, in Figure 5 it is impossible to understand which profile belongs to K or N or Zn or Cr. Perhaps the applicants can provide a different identification key which clearly associates each profile with the proper element. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because all of the drawings contain the designations "Diagram 1" and "Diagram 2." These designations should be removed from all of the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Double Patenting***

Applicant is advised that should claim 1 be found allowable, claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

***A. The following is a quotation of the first paragraph of 35 U.S.C. 112:***

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

***1. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This application is a continuation of Serial Number 09/171,558 (now U.S. Patent No. 6,287,704). The original specification does not mention a chromium content *of up to approximately 1% across the conversion layer thickness*. See line 66 in column 4 to line 13 in column 5.***

***2. Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This application is a continuation of Serial Number 09/171,558 (now U.S. Patent No. 6,287,704). The original specification does not mention the application of additional inorganic and/or organic layers on the conversion layer.***

***3. Claims 29 and 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This application is a continuation of Serial Number 09/171,558 (now U.S. Patent No. 6,287,704). The original specification does not mention only a***

conversion layer having an average chromium content of more than approximately 5%. See line 66 in column 4 to line 13 in column 5. Note that the original specification requires a *conversion layer having across the conversion layer thickness a chromium content of greater than 1% based upon zinc and chromium*. Similarly, the original specification does not provide only a conversion layer having an average chromium content of more than approximately 5% and containing the various materials recited in new claim 36.

**4.** Claims 1 to 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This application is a continuation of Serial Number 09/171,558 (now U.S. Patent No. 6,287,704). The specification of this patent application does not include important information about the chemical components of the passivation bath, the conversion coating concentrate, and the chemical composition of a chromium (VI)-free conversion coating layer. The Examiner believes that significant portions of the original specification (for example, line 14 in column 4 to line 40 in column 7) have been omitted from this patent application.

**B.** The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**1.** Claims 1 and 31 to 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is rejected as being vague and indefinite because the "chromium index > approx. 10" is not defined in the claim.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation "additional metal

compounds" and "anions" and "silicon-containing anions" and "polymers" and "amino acids" and "silicic acids" and "organic acids" and "pigments", and the claim also recites "1- to 6-valent metal compounds" and "halide ions" and "silicate anions" and "organic polymers" and "glycin" and "disperse silicic acids" and "monocarboxylic acids" and "carbon black" which is the narrower statement of the range/limitation.

Regarding claim 3, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "a metallic surface",

and the claim also recites "one of zinc or zinc alloys, in particular with iron" which is the narrower statement of the range/limitation.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is rejected as being vague and indefinite because the concentration of the chromium (III) complex is not recited.

6. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 are rejected as being vague and indefinite because each claim uses comparative language (i.e., the word "basis" in claim 4 and the wording "inherent color" in claim 5) which does not permit a definite description of the claimed conversion layer.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by

raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation "an elevated temperature", and the claim also recites "20 to 100° C" and "20 to 80° C" and "30 to 60° C" and "40 to 60° C" which is the narrower statement of the range/limitation.

**8.** Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**9.** Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by

raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation "surfaces of zinc or zinc alloys", and the claim also recites "in particular ones with iron" which is the narrower statement of the range/limitation.

**10.** Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**11.** Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by

raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 13 recites the broad recitation "additional metal compounds" and "anions" and "sulfurous ions" and "phosphoric ions" and "silicon-containing anions" and "polymers" and "silicic acids" and "organic acids" and "pigments" and "amino acids" and "siccatives", and the claim also recites "1- to 6-valent metal compounds" and "halide ions" and "sulfate ions" and "phosphate ions" and "silicate anions" and "organic polymers" and "disperse silicic acids" and "monocarboxylic acids" and "carbon black" and "glycin" and "cobalt siccatives" which is the narrower statement of the range/limitation.

Regarding claim 13, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**12.** Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

"such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 14 recites the broad recitation "metal surfaces", and the claim also recites "in particular ones of zinc, cadmium or aluminum, or alloys of these metals among each other and/or with other metals, in particular with iron" which is the narrower statement of the range/limitation.

**13.** Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481

(Bd. App. 1949). In the present instance, claim 15 recites the broad recitation "approx. 5 g/l to 80 g/l", and the claim also recites "5 g/l to 60 g/l" and "10 g/l to 30 g/l" and "approx. 20 g/l" which is the narrower statement of the range/limitation.

**14.** Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 18 recites the broad recitation "further additives" and "additional metal compounds" and "anions" and "sulfurous ions" and "phosphoric ions" and "silicon-containing anions" and "silicic acids" and "organic acids" and "pigments" and "chromogenic agents" and "amino acids" and "siccatives", and the claim also recites "sealers" and "1- to 6-valent metal compounds" and "halide ions" and "sulfate ions" and "phosphate ions" and "silicate anions" and "disperse silicic acids" and "monocarboxylic acids" and "carbon black"

and "metallic chromogenic agents" and "glycin" and "cobalt siccative" which is the narrower statement of the range/limitation.

Regarding claim 18, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**15.** Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 19 recites the broad recitation "approx. 20 to 100° C", and the claim also recites "20 to 80° C" and "30 to 60° C" and "40 to 60° C" which is the narrower statement of the range/limitation.

**16.** Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 20 recites the broad recitation "surfaces of zinc or zinc alloys", and the claim also recites "in particular ones with iron" which is the narrower statement of the range/limitation.

**17.** Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the

explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 21 recites the broad recitation "between approx. 15 and 200 seconds", and the claim also recites "between approx. 15 and 100 seconds" and "approx. 30 seconds" which is the narrower statement of the range/limitation.

**18.** Claims 29 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 29 and 36 are rejected as being vague and confusing because claim 29 requires two chromium concentrations in the conversion layer which appear to conflict with each other. In one instance, the conversion layer has an average chromium content of more than approximately 5% and, at the same time, the conversion layer broadly has greater than 1% Cr.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 14 to 21, 24 to 27, and 30 to 35 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,368,655 (Klos).

Klos discloses a process for chromating an article formed of a metal selected from the group consisting of zinc, cadmium, and alloys thereof, which includes immersing the article in an aqueous solution of a soluble chromic oxalate complex having a pH from 1.2 to 3.0. The passivation solutions disclosed by Klos do not contain any fluoride ions or fluorine compounds, and the dissolved chromium is present only as Cr<sup>3+</sup> ions. Hexavalent chromium ions are specifically excluded from the passivation solutions. See line 50 in column 2 to line 63 in column 4. The chromating solutions disclosed by Klos provide good corrosion resistance for coated metal articles. According to the data in Table 3 (column 4), several oxalate-Cr<sup>3+</sup> coating solutions can provide at least 100 hours of corrosion resistance to metal articles subjected to a standard salt spray test.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Robert Koehler whose telephone number is (703) 308-1974. The Examiner can normally be reached on Tuesday to Friday from 8:30 AM to 6:00 PM. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on (703) 308-3822. The fax phone number for this Art Unit is (703) 305-5436 or (703) 872-9310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0661.



**ROBERT R. KOEHLER**  
**PRIMARY EXAMINER**

**Art Unit 1775**

**April 21, 2002**